

REMARKSClaims 27, 29 and 31 and new Claims 49-54

Applicants acknowledge the Examiner's determination that Claim 27 is allowable. New Claims 49 and 51 depend from Claim 27, and new Claim 52 depends from Claim 51. As such, new Claims 49, 51 and 52 should also be allowable. Support for new Claims 49, 51 and 52 is found throughout the specification, for example, at page 2, lines 34-36 and page 13, lines 26-28.

The Examiner has objected to Claims 29 and 31 as depending upon a rejected base claim and indicates that Claims 29 and 31 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 29 and 31 have been amended as suggested by the Examiner, thereby making the claims allowable. New Claims 50 and 53 depend from Claim 29, and new Claim 54 depends from Claim 53. As such new Claims 50, 53 and 54 should also be allowable. Support for new Claims 50, 53 and 54 are found throughout the specification, for example, at page 2, lines 34-36 and page 13, lines 26-28.

Request for Rejoinder of Claims 32-38, 40-42 and new Claims 55-64 Pursuant to MPEP § 821.04

Applicants requests that method Claims 32-38, 40-42 and 55-64 be rejoined, pursuant to U.S. Patent Office practice (M.P.E.P. § 821.04) in view of the allowability of Claims 27 and 29.

Claims 32-38 and 40-42, which are currently withdrawn from consideration, have been amended to be directed to the use of the monoclonal antibody product of Claim 27. Thus, as amended, method Claims 32-38 and 40-42 include all the limitations of the antibody product of Claim 27. Accordingly, since Claim 27 has been found to be allowable, method Claims 32-38 and 40-42, which are drawn to methods of using the antibody product of Claim 27, should also be allowable.

New method Claims 55-64, which are similar to Claims 32-38 and 40-42, are directed to the use of the monoclonal antibody product of Claim 29. Thus, new method Claims 55-64 include all the limitations of the antibody product of Claim 29. Accordingly, if Claim 29 is found to be allowable, method Claims 55-64, which are drawn to methods of using the antibody product of Claim 29, should also be allowable.

Paragraph 6: Biological Deposit

Applicants acknowledge the Examiner's determination that the declaration of biological deposit and statement under 37 C.F.R. § 1.806 and § 1.808 concerning DSM Deposit No. ACC2388, filed April 24, 2003, are sufficient to satisfy the requirement for deposit of biological materials under 35 U.S.C. § 112, first paragraph.

Paragraph 7: Information Disclosure Statement

The Examiner states that the Information Disclosure Statement (IDS) filed April 24, 2003 fails to comply with 37 C.F.R. § 1.9(c) because it lacks the fee set forth in 37 C.F.R. § 1.17(p).

Respectfully, Applicants did not file an IDS on April 24, 2003. The IDS attached as Exhibit 1 to the Amendment filed on April 24, 2003 had been originally filed on February 22, 2002 under 37 C.F.R. § 1.97(b). The filing of this IDS was prior to the mailing of the first office action on the merits and, as such, no fee was required.

In the Office Action dated November 20, 2002 (Paper No. 11), the Examiner had acknowledged, *inter alia*, Applicants' IDS filed February 22, 2002 (Paper No. 6). See Paper No. 11, at page 3. However, initialed copies of the PTO-1449 filed February 22, 2002 (5 sheets) had not been attached to Applicants' copy of Paper No. 11. As such, in response to Paper No. 11, Applicants had requested entry and consideration of Paper No. 6 (IDS, Form PTO-1449 (5 sheets)) and had attached copies of the postcard receipt and Paper No. 6 thereto for convenience.

Accordingly, entry and consideration of the IDS filed February 22, 2002 (Paper No. 6) are respectfully requested.

Paragraph 8: Formal Drawing

In the Proposed Drawing Correction filed concurrently herewith, Applicants have requested cancellation of the sole Figure in the application to facilitate compliance with the drawing requirements. No new matter is added by this amendment.

The substance of the Figure is described in detail in the specification. In particular, the Figure shows the results of a Western Blot analysis using a monoclonal antibody according to the invention and a polyclonal antibody known in the art. The specific results are described in detail in the specification at page 3, line 27 through 34, where it is said that:

the antibody according to the present invention recognises only one band while the polyclonal antibody detects further bands in the range of 90 to 50 kDa. H denotes HeLa cells and C denotes CHO cells.

The specific results of the Figure are also described at page 18, lines 26 through 34, where it is said that:

the polyclonal anti-Mcm3 rabbit antibody revealed, besides the expected prominent main protein band with an apparent molecular weight of 105 kDa, further proteins in the molecular weight range between 50 kDa and 90 kDa.

The monoclonal anti-Mcm3 antibody according to the invention revealed only the expected protein band with an apparent molecular weight of 105 kDa.

Thus, in view of the above detailed description appearing in the specification, to avoid needless duplication, the Figure has been canceled.

Paragraph 9: Specification Amendment

The specification has been amended in accordance with the cancellation of the Figure.

Paragraphs 10 and 11: Rejection of Claim 26 Under 35 U.S.C. § 112, Second Paragraph

The Examiner has maintained the rejection of Claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner maintains that recitation of the phrase "same binding properties" renders Claim 26 indefinite because "[i]t is unclear what properties are contemplated."

Applicants respectfully disagree with this assessment. However, in an effort to advance prosecution in the subject application, Claim 26 has been canceled without prejudice.

Paragraph 12: Rejection of Claims 25, 26, 28, 30, 39 and 43 Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of Claims 25, 26, 28, 30, 39 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Tsuruga *et al.* (*Biochem. Biophys. Research Comm.*, 236:118-125 (1997)) in view of Harlow *et al.* (*Antibodies: A Laboratory Manual* (1998)) and U.S. Patent No. 5,876,438 for the reasons set forth in Paper No. 11.

Applicants respectfully disagree with the Examiner's assessment that Claims 25, 26, 28, 30, 39 and 43 are obvious in view of the cited art for the reasons of record. However, in an effort to advance prosecution in the subject application, Claims 25, 26, 28, 30, 39 and 43 have been canceled without prejudice to their prosecution in a continuation or divisional application, thereby rendering this rejection moot.

Paragraphs 13 and 14: Rejections of Claim 46 and 46 Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of Claim 46 under 35 U.S.C. § 103(a) as being unpatentable over Tsuruga *et al.* in view of Harlow *et al.* and U.S. Patent No. 4,281,061 ('061) for the reasons set forth in Paper No. 11. The Examiner has also maintained the rejection of Claim 47 under 35 U.S.C. § 103(a) as being unpatentable over Tsuruga *et al.* in view of Harlow *et al.*, U.S. Patent No. 4,281,061 ('061) and further in view of U.S. Patent No. 6,316,208 ('208) for the reasons set forth in Paper No. 11.


Applicants respectfully disagree with the Examiner's assessment that Claims 46 and 47 are obvious in view of the cited art for the reasons of record. However, in an effort to advance prosecution in the subject application, Claims 46 and 47 have been canceled without prejudice to their prosecution in a continuation or divisional application, thereby rendering these rejections moot.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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